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10/734,437

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Michael J. Muller

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EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/734,437

Applicant(s)

MULLER, MICHAEL J.

Examiner

DOUGLAS B. BLAIR

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/13/04 and 4/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The applicant's specification does not provide any description of what the computer usable medium in claim 26 comprises. For examination purposes the computer usable medium is interpreted as the carrier wave discussed in paragraph 8 of the applicant's specification as the Examiner can find no other element that seems to fit the claimed medium.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 26-32 are rejected to being directed towards a computer usable medium that is interpreted as a carrier wave. Claims 33-39 are directed towards a signal embodied on a carrier wave. Carrier waves do not fit into any statutory category of invention and therefore are not patentable.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 2, 13, 20, 27, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 13, 20, 27, and 34 all state a limitation where a second email message is a first email message. This language creates a contradiction with the claims that they depend upon because the fact that there is a second message implies that there is a second message that is different from a first message, otherwise it would have just been referred to as the first message. A dependent claim can narrow an independent claim but it cannot contradict the claim it depends upon. If the applicant is trying to claim that the "second email message is a copy of the first email message" then such a relationship should be claimed explicitly.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,555,346 to Gross et al.

As to claim 1, Gross teaches a method of managing email messages in an email account, the method comprising: displaying a user a first email message on a display screen of a device (col. 4, lines 14-39, the system features an electronic mail application and thus can display a message); presenting the user with a plurality of deletion options in response to detecting an

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intent of the user to perform an action on the first email message (Figure 10F, the displayed options are performed any message displayed in the electronic mail application); receiving an input signal from the user that selects one of deletion options (Figure 10F); and in response to the input signal, performing the action on the first email message and setting a deletion criterion for a second email message based on the selected deletion option (Figure 10F, selecting one of the options will perform the action on the first message and set a deletion criteria for any other messages).

As to claim 2, closing an email message is inherent to any email application.

As to claim 3, Gross teaches the action is to send the first email message and the second email message is a copy of the sent first email message (Figure 10F, the rules apply to the sent mail folder as well as the inbox, therefore first messages a sent and the sent mail folder contains the second messages to be deleted).

As to claim 4, Gross teaches the method of claim 1, wherein the step of setting the deletion criterion for the second email message includes associating deletion of the second email message to an occurrence of a scheduled item (col. 5, line 65-col. 6, line 10).

As to claims 5 and 6, Gross teaches the method of claim 4, wherein the scheduled item is an appointment in a calendar or a task in a task list (col. 5, line 65-col. 6, line 10).

As to claim 7, Gross teaches the method of claim 1, wherein the step of setting the deletion criterion for the second email message includes scheduling deletion of the second email message to a specified time (col. 5, line 65-col. 6, line 10).

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As to claim 9, Gross teaches the method of claim 1, further comprising defining by the user each deletion option to be presented (In Figure 10F, the deletion options have fields which are defined by the user).

As to claims 12-16, 19-23, 26-30, and 33-37, these claims are rejected for the same reasoning as claim 1 and its dependents since they feature the same limitations.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 10-11, 17-18, 24-25, 31-32, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,555,346 to Gross et al. in view of U.S. Patent Application Publication Number 20020090933 by Rouse et al.

As to claim 8, Gross teaches the method of claim 1; however Gross does not explicitly teach prompting a user for confirmation before deleting an email.

Rouse teaches a method of prompting a user for confirmation before deleting an email (paragraph 70).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gross regarding the management of deletions with Rouse regarding the prompting for confirmation of deletions because prompting provides

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an additional layer of data protection and combining the two references would not require any modification of either references and would produce a predictable result is combined.

As to claim 10, Gross teaches the method of claim 1, however Gross does not explicitly teach displaying a mailbox view listing a plurality of email messages, and providing an indicator for each email message scheduled for deletion

Rousse teaches a method comprising displaying a mailbox view listing a plurality of email messages (Figure 6), and providing an indicator for each email message scheduled for deletion (paragraph 70).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gross regarding the management of deletions with Rousse regarding displaying a listing and providing an indicator for mail scheduled to be deleted because providing a user with visual confirmations provides an additional layer of data protection and combining the two references would not require any modification of either references and would produce a predictable result is combined.

As to claim 11, Gross teaches the selection of deletion criterion and Rousse teaches an indicator of deletion. It would have been obvious to combine the two concepts for the reason discussed in the rejection of claim 10.

As to claims 17-18, 24-25, 31-32, and 38-39, these claims are rejected for the same reasons as claims 10 and 11.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/  
Examiner, Art Unit 2142